

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Glock et al.

Art Unit: 1616
Examiner: Qazi, Sabiha Naim

Intl. Appln. No.: PCT/EP00/08658
IA Filing Date: September 5, 2000
U.S. Appln No.: 10/070,936
§ 371 Date: August 9, 2002
For: HERBICIDAL COMPOSITION

Conf. No. 4690

Action: **PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this Request.

This Request is being filed with a Notice of Appeal and the appeal fee.

The Review is being requested for the reasons stated on the sheets attached hereto.

Applicants do not believe any additional fees are due with this request. If additional fees are due, please charge the required fees to Deposit Account No. 50-1676 in the name of Syngenta Crop Protection, Inc.

Respectfully submitted,

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Date: August 13, 2008

REMARKS

Claims 1-17 are pending in the application.

Claims 1-7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Muhlebach.

Claims 1-17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Muhlebach in view of Hazen.

Claims 1-17 stand rejected under 35 U.S.C. § 112, ¶ 1 for failing to comply with the written description requirement.

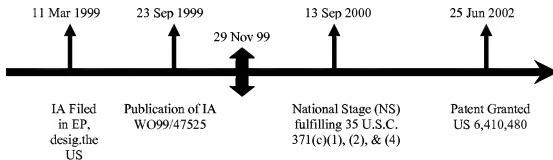
Applicants respectfully request reconsideration of the pending claims in light of the following remarks.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Muhlebach et al, WO 99/47525.

Claims 1-17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Muhlebach et al, WO 99/47525 in view of Hazen.

As previously discussed, Applicants note that the primary reference of Muhlebach does not qualify as prior art. Applicants provide the Muhlebach application timeline below:



Applicants submit the following language from MPEP 706.02(f)(1) as guidance, page 700-35:

The reference U.S. patent issued from an international application (IA) that was filed prior to November 29, 2000 has a 35 U.S.C. 102(e) prior art date of the date of fulfillment of the requirements of 35 U.S.C. 371(c)(1), (2) and (4). This is the pre-AIPA 35 U.S.C. 102(e). *The application publications, both the WIPO publication and the U.S. publication, published from an international application that was filed prior to November 29, 2000, do not have any 35 U.S.C. 102(e) prior art date. [...] The application publications can be applied under 35 U.S.C. 102(a) or (b) as of their publication dates.*

Therefore, Applicants submit that the Muhlebach IA publication has no 102(e) date, and a 102(a), (b) date of September 23, 1999. Applicants further submit that the Muhlebach patent, US 6,410,480, has a 102(e) date of September 13, 2000.

Applicants' application claims priority to CH 1641/99 having a priority date of September 7, 1999, which precedes any of the Muhlebach 102 prior art dates.

As the primary reference cannot be asserted against the present claims, the rejection of claims 1-7 cannot be maintained.

Similarly, with respect to the rejection of claims 1-17 as being unpatentable over Muhlebach in view of Hazen, Applicants respectfully request withdrawal of the rejection. As the Muhlebach reference does not qualify as prior art, the Examiner has not shown that Hazen alone teaches or suggests the present invention at the time the invention was made. Accordingly, Applicants request withdrawal of the rejection.

REJECTIONS UNDER 35 U.S.C. § 112 ¶ 1

In the Office Action, the Examiner maintains the previous rejection of the claims under 35 U.S.C. § 112 for failing to comply with the written description requirement.

Applicants continue to disagree with the Examiner's § 112 rejection. Applicants have substantially amended claim 1 for the Examiner's consideration. Applicants' submit that the present specification contains a written description of the invention, and of the manner and process of making it, in such in full, clear, and exact terms as to enable one ordinary skilled in the art to make and use the same.

The herbicidal composition currently claimed in amended claim 1 is comprised of a compound of formula I and at least one co-herbicide selected from 29 specific co-herbicides.

The Examiner may appreciate that amended claim 1 is significantly narrower in scope than as originally filed. Indeed, the compound of formula (I) as now recited has the general structure represented as (Ie) in Applicants' specification. Applicants' specification provides numerous examples of compounds having the general structure of formula (Ie). These examples can be found in Applicants' specification, for example, in Table 1 located on pages 25-30.¹

The 29 co-herbicides remaining in amended claim 1, and the increased herbicidal action exhibited by these co-herbicides in combination with the selected compound of formula (I) is clearly

¹ The page numbers referenced correlate to the pagination of WO 01/17351

described in Applicants' specification in such a way as to reasonably convey to one skilled in the art that the inventors has possession of the claimed invention at the time of filing. Applicants have at a minimum illustrated a representative sample of the selective herbicidal action of the compound of formula I and each of the 29 herbicides.

Reference is made to pages 39-45 of the present specification, as well as the five Declarations of Jutta Glock submitted in response to the Office Action dated February 23, 2005. Particularly, the specification and the Declarations demonstrate the herbicidal action of over 30 different compositions comprised of a selected compound of formula (I) and a selected co-herbicide. Specifically, the Examiner's attention is directed to all five of the Glock Declarations submitted May 17, 2005 and pages 40-44 of the present specification wherein the synergism is demonstrated between a selected compound of formula (Ie) and the following members of the 29 co-herbicides listed below:

<ul style="list-style-type: none"> • <i>Clodinafop-P-propargyl</i> • <i>Fenoxaprop-P-ethyl</i> • <i>Tralkoxydim</i> • <i>Triasulfuron</i> • <i>Amidosulfuron</i> • <i>Tribenuron</i> • <i>Idosulfuron</i> • <i>Thifensulfuron-methyl</i> • <i>Metsulfuron</i> 	<ul style="list-style-type: none"> • <i>Flupyralsulfuron</i> • <i>Sulfosulfuron</i> • <i>Mecoprop</i> • <i>Fluroxypyr</i> • <i>MCPA</i> • <i>2,4-D ester</i> • <i>2,4-D amine</i> • <i>Triallate</i> • <i>Prosulfocarb</i> 	<ul style="list-style-type: none"> • <i>Dicamba</i> • <i>Diffluenican</i> • <i>Bromoxynil</i> • <i>loxylinil</i> • <i>Florasulam</i> • <i>Flucarbazone</i> • <i>Propoxycarbazone</i> • <i>Metosulam</i>
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Applicants respectfully submit that they have provided more than a sufficient number of representative examples such that one of skill in the art would expect that any select compound of formula (I) and second herbicide as claimed would be expected to perform in the same manner without undue experimentation. To argue the contrary will require more than a general allegation that Applicants' disclosure would have not taught one skilled in the art how to make and use the full scope of the claimed invention. Indeed, as provided in MPEP § 2164.03. "[p]roof of enablement will be required for other members of the claimed genus *only where adequate reasons* are advanced by the examiner to establish that a person skilled in the art could not use the genus as a *whole* without undue experimentation." (MPEP § 2164.03, p. 2100-196).

Applicants note that, as currently claimed, the variants for formula I are limited and include only three (3) functional groups defining the G substituent, i.e., hydrogen, carboxylic acids and carboxylic esters, while the definitions for R¹ and R² are limited to only alkyl, alkyloxy, alkynyl, halogenated alkyl and halogenated alkyloxy. Given the teachings of the specification and the

compounds exemplified in the table at pages 25-30, Applicants respectfully submit that the specification exemplifies a representative sample of these compounds such that one of ordinary skill in the art would be able to make and use all compounds embraced by the claims without undue experimentation. Absent concrete examples of compounds falling within the claims that are not enabled, Applicants respectfully submit that the Examiner has failed to establish lack of enablement. Respectfully, Applicants request withdrawal of the rejection under 35 USC § 112.

Based upon the foregoing then, Applicants submit that the pending claims are in condition for allowance and the Examiner is courteously solicited to pass this application on to allowance. No other fees are believed to be payable at this time. However, the Commissioner is authorized to debit any applicable fees from the deposit account of the undersigned, no 50-1676 in the name of Syngenta Crop Protection, Inc.

Respectfully submitted,

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